

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 149-0161US
via USPTO EFS	Application Number 09/855,042	Filed 5/14/2001
	First Named Inventor David A. Solin	
	Art Unit 2168	Examiner Greta Lee Robinson
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38559</u> </div> <div style="width: 45%; text-align: right;"> <u>/Coe F. Miles/</u> Signature <u>Coe F. Miles</u> Typed or printed name <u>832-446-2418</u> Telephone number <u>7/17/07</u> Date </div> </div> <div style="display: flex; justify-content: space-between; margin-top: 10px;"> <div style="width: 45%;"> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </div> <div style="width: 45%;"></div> </div>		
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p>		
<div style="border: 1px solid black; padding: 2px;"> <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. </div>		

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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Title : SYSTEM AND METHOD FOR UPDATING INFORMATION ON A COMPUTER
USING A LIMITED AMOUNT OF SPACE

Inventors : David A. Solin

Serial No. : 09/855,042

Filed : 14 May 2001

Examiner : Greta Lee Robinson

Art Unit : 2168

Docket : 149-0161US

Customer : 29855

Mail Stop AF,
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner's Rejection of Claims Based on 35 USC § 101 is Without Merit

The Examiner's position appears to be that if each element does not provide a useful, concrete and tangible result, the entire claim is non-statutory for failing to provide a useful, concrete and tangible result. This is simply not the law. It is well established that claims must be evaluated as a whole. The piecemeal analysis focusing on individually claimed elements is not permitted.

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."). M.P.E.P. 2106 (II) (C)

When taken as a whole it is undeniable that each and every claim recites a useful, concrete and tangible result - updating a computer system. For this reason alone the claimed inventions are patentable. See also, Assignee's remarks in the Reply to Office Action dated 3 Nov. 2006 (filed 2 Feb. 2007) at pages 12-13, section B.

It is further noted that the recited act of "RECIEVEING A SECOND SET OF UPDATE INFORMATION RESPONSIVE TO THE REQUEST" is itself a concrete and tangible act, the usefulness of which, *inter alia*, is its support of a "computer system update". See, for example, dependent claims 6 and 7 that further utilize the second received message.

In summary, a claim is not directed to unpatentable subject matter if it, as a whole, produces a useful, concrete and tangible result. Each and every pending claim does this, *ergo*; the Examiners rejection under 35 U.S.C. § 101 is improper.

Examiner's Rejection of Claims Based on 35 USC § 112 2nd Paragraph is Without Merit

The Examiner's position appears to be that the specification dictates the elements that must appear in the claims. This is not the law. The Examiner appears to have used her imagination to make the claimed elements essential when the Assignee has merely described several of the many alternate embodiments of the invention. Assignee has never identified any element as essential. Assignee has recited elements that particularly point out and distinguish the claimed invention from the cited prior art. This is all the law requires.

Compliance with 35 U.S.C. § 112, second paragraph, only requires:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

M.P.E.P. 2171

See Assignee's remarks in the Reply to Office Action dated 3 Nov. 2006 (filed Feb. 2 2007) at page 14, section D.

It is further noted that forcing Assignee to limit the claimed invention to a preferred embodiment, in the absence of cited prior art, would be inappropriate.

"Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality."

MPEP 2164.08(C)

In summary, an element described in the Specification's "Detailed Description" does not by itself make that element critical. A rejection based on 35 USC 112 "should be made only when the language of the specification makes it clear that the limitation is critical". The language of the specification makes no such assertion, therefore, the Examiners rejection under 35 U.S.C. § 112 is improper.

Reconsideration of the claims in light of the above remarks is respectfully requested.

/Coe F. Miles, Ph.D., J.D./
Reg. No. 38,559

Date: 17 July 2007

Wong, Cabello, Lutsch, Rutherford & Brucculeri, L.L.P.

Customer No. 29855
20333 SH 249, Suite 600
Houston, Texas 77070

Voice: 832-446-2418
Mobile: 713-502-5382
Facsimile: 832-446-2458

Email: cmiles@counselIP.com